



UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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SEP 11 2002

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In re Application of :
Federico Mailland :
Serial No.: 10/016,005 : PETITION DECISION
Filed: November 1, 2001 :
Attorney Docket No.: 9056-5CT :

This is in response to applicant's petition under 37 CFR 1.181, filed June 17, 2002, requesting withdrawal of finality of an Office action.

A review of the file history shows that this application was filed November 1, 2001 and is a continuation of SN 09/454,364, filed December 3, 1999. Subsequent to the filing of this application applicant filed a preliminary amendment which was received in the Office on April 10, 2002 (Certificate of Mailing dated March 28, 2002). On April 3, 2002, the examiner mailed a first Office action which was a Final rejection to applicant, setting a three month shortened statutory period for reply. It is noted that the summary page of the Office action indicates that the Office action is a Final rejection, however the body of the Office action gives no reasons for and does not confirm that the Office action is a Final rejection.

37 CFR 1.115 states as follows (note also M.P.E.P. 714.03(a):

- (a) A preliminary amendment is an amendment that is received in the Office (§ 1.6) on or before the mail date of the first Office action under § 1.104.
- (b)(1) A preliminary amendment will be entered unless disapproved by the Commissioner. A preliminary amendment may be disapproved if the preliminary amendment unduly interferes with the preparation of a first Office action in an application. Factors that will be considered in disapproving a preliminary amendment include:
 - (i) The state of preparation of a first Office action as of the date of receipt (§ 1.6) of the preliminary amendment by the Office; and
 - (ii) The nature of any changes to the specification or claims that would result from entry of the preliminary amendment.
- (2) A preliminary amendment will not be disapproved if it is filed no later than:
 - (i) Three months from the filing date of an application under § 1.53(b);
 - (ii) The filing date of a continued prosecution application under § 1.53(d); or
 - (iii) Three months from the date the national stage is entered as set forth in § 1.491 in an international application.
- (c) The time periods specified in paragraph (b)(2) of this section are not extendable.

It is noted that the amendment was not received within three months of the filing of the application and was actually received after preparation and mailing of the Office action. M.P.E.P. 714.01(e) addresses consideration of preliminary amendments received after the mailing of an Office action, as follows:

A preliminary amendment is an amendment that is received in the Office on or before the mail date of the first Office action under 37 CFR 1.104. See 37 CFR 1.115(a). If the date of receipt (37 CFR 1.6) of the amendment is later than the mail date of the first Office action and is not responsive to the first Office action, the Office will not mail a new Office action, but simply advise the applicant that the amendment is nonresponsive to the first Office action and that a responsive reply must be timely filed to avoid abandonment. See MPEP § 714.03.

Preliminary amendments should either accompany the application or be filed after the application has received its application number and filing date. See MPEP § 502.

In view of the guidance of the M.P.E.P. the preliminary amendment received April 10, 2002, will be treated as a response to the Office action mailed April 4, 2002. Because that Office action did not confirm the finality thereof in the body of the Office action it will be considered a non-Final Office action.

DECISION

Applicant's petition is **GRANTED**. The Finality of the last Office action, mailed April 4, 2002, is withdrawn.

The application will be forwarded to the examiner for consideration of the amendment filed April 10, 2002.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230..


John Doll
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